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In re application of: Philippe RENARD et al.

Attorney Docket No. P21515

Application No. : 09/977,698

**Mail Stop Amendment**  
 Group Art Unit : 1774

Filed : October 16, 2001

Examiner : Merrick L. Dixon

For : THIN COMPOSITE LAMINATE AND USE THEREOF IN MAKING SPORTS ARTICLES,  
 ESPECIALLY BOOTS

**Mail Stop Amendment**

Commissioner for Patents  
 U.S. Patent and Trademark Office  
 Customer Service Window, Mail Stop Amendment  
 Randolph Building  
 401 Dulany Street  
 Alexandria, VA 22314

Sir:

Transmitted herewith is a **Petition under 37 C.F.R. 1.127 From Refusal of Primary Examiner to Admit Amendment** in the above-captioned application.

- ☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.
- ☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
- ☐ A Request for Extension of Time.
- ☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 26	*57	0	x25=	\$	x 50=	\$0.00
Indep. Claims: 2	**3	0	x100=	\$	x200=	\$0.00
Multiple Dependent Claims Presented			+180=	\$	+360=	\$0.00
Extension Fees for ___ Month(s)				\$		\$0.00
			Total:	\$	Total:	\$0.00

\* If less than 20, write 20

\*\* If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$ \_\_\_\_.

☒ A check in the amount of \$ \_\_\_\_ to cover the filing/extension fee is included.

☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).

  
 James L. Rowland  
 Reg. No. 32,674

USPTO



U.S. Patent Appln. No. 09/977,698  
P21515.A11 (S 861/US)

PATENT APPLICATION  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants	: Philippe RENARD et al.	)	
Appln. No.	: 09/977,698	)	Group Art Unit 1774
Docket No.	: P21515	)	Examiner Merrick L. Dixon
Customer No.	: 7055	)	Confirmation No. 3771
Filed	: October 16, 2001	)	
Title	: THIN COMPOSITE LAMINATE AND USE THEREOF IN MAKING SPORTS ARTICLES, ESPECIALLY BOOTS	)	

**PETITION UNDER 37 CFR §1.127  
FROM REFUSAL OF PRIMARY EXAMINER TO ADMIT AMENDMENT**

U.S. Patent and Trademark Office  
Customer Service Window, **Mail Stop AF**  
Randolph Building  
401 Dulany Street  
Alexandria, VA 22314

Sir:

Applicants herein petition under 37 CFR §1.127 from the refusal of the Primary Examiner to enter Applicants' amendment, filed on August 23, 2005, in reply to the final rejection dated July 13, 2005. Pursuant to 37 CFR §1.127, this petition is being filed in accordance with the provisions of 37 CFR §1.181. To this end, as provided in 37 CFR §1.181(b), Applicants have below presented a statement of facts involved, the points to be reviewed, and the action requested.

**I. Statement of Facts**

**A. Summary of Amendment**

On August 23, 2005, Applicants filed a reply under 37 CFR §1.116 to the final Office action dated July 13, 2005, which was intended to place the instant application in condition for allowance. In this regard, and relevant to the denial of entry of the amendment, Applicants amended two independent claims, viz., claims 73 and 74, in a manner consistent with statements in the final Office action to advance prosecution to allowance.

**1. Independent Claim 73**

First, independent claim 73 was amended to incorporate therein the subject matter of former claim 25, which had depended directly from claim 73, and which claim was identified in the final Office action to be allowable. Specifically, Section 3 on page 2 of the final Office action includes the following:

Claims 25, 29, 30-32, 37-39, 41, 42, 51-55 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim 25, at the time of the final Office action and prior to Applicants' reply thereto, appeared as follows (see page 3 of Applicants' reply, filed on April 18, 2005, to the first Office action; underlining and strikethrough markings have been omitted):

Claim 25. A laminate according to claim 73, wherein:

the fibers of the core comprise a member selected from the group consisting of synthetic fibers, natural fibers, cellulose fibers, or a mixture of any of combination of synthetic, natural, and cellulose fibers;

the synthetic fibers comprise a member selected from the group consisting of polyamide fibers, polyolefine fibers, polyester fibers, and polyesterimide fibers;

the natural fibers comprise a member selected from the group consisting of silk fibers, cotton fibers, linen fibers, jute fibers, and hemp fibers.

Independent claim 73, then, was amended in Applicants' reply to the final Office action to overcome the §112, second paragraph rejection and to incorporate the subject matter of allowable claim 25, as follows (see page 7 of Applicants' reply, filed on August 23, 2005, to the final Office action; underlining and strikethrough markings being retained):

Claim 73. (*Currently Amended*) A laminate comprising:

a sandwich structure comprising:

two layers of a composite material containing fibers;

a core consisting essentially of a fiber-reinforced composite material, said core being positioned between the two layers;

at least a portion of the fibers of the core having a mechanical strength significantly lower than a mechanical strength of at least a portion of the fibers of at least one of the two layers;

the fibers of the core comprising a member selected from the group consisting of synthetic fibers, natural fibers, cellulose fibers, or a mixture of any of combination of synthetic, natural, and cellulose fibers, the synthetic fibers comprising a member selected from the group consisting of polyamide fibers, polyolefine fibers, polyester fibers, and polyesterimide fibers, and the natural fibers comprising a member selected from the group consisting of silk fibers, cotton fibers, linen fibers, jute fibers, and hemp fibers.;

the laminate having a total thickness  $e$  less than or equal to 3 mm;

the core having a thickness  $e_2$  and the two layers have a total thickness  $e_3 + e_4$ , a ratio between the thickness of the core and the total thickness of the two layers being defined as follows:

$$e_2 / \frac{e_3 + e_4}{2} \leq 5.$$

## **2. Independent Claim 74**

Second, independent claim 74 was amended merely for cosmetic reasons, to improve its form, in response to the following rejection of claim 74 (see page 2, Section 2, of the final Office action):

In line 11, the phrase, "the predetermined magnitude" is vague and indefinite and not understood. Applicants are requested to provide better claim language. Same phrase also lacks proper antecedent basis. Applicants are requested to make related corrections.

Claim 74, at the time of the final Office action and prior to Applicants' reply thereto, appeared as follows (see page 8 of Applicants' reply, filed on April 18, 2005, to the first Office action; the "offending" phrase "the predetermine magnitude" is shown in **bold**):

Claim 74. (New) A laminate comprising:

a sandwich structure having a total thickness no greater than 3 mm, said sandwich structure comprising:

a core consisting essentially of a composite, the composite comprising a polymer resin matrix reinforced with fibers, the fibers of the composite consisting essentially of fibers having a mechanical strength no greater than a predetermine magnitude defined as a modulus M in longitudinal traction of less than or equal to 50,000 Mpa;

two fiber-reinforced composite layers, the core being positioned between the two layers, fibers of the two layers being different from the fibers of the core;

both of the two fiber-reinforced composite layers having a mechanical strength greater than **the predetermine magnitude** of the mechanical strength of the fibers of said core;

the core having a thickness  $e_2$  and the two layers have a total thickness  $e_3 + e_4$ , a ratio between the thickness of the core and the total thickness of the two layers being defined as follows:

$$e_2 / \frac{e_3 + e_4}{2} \leq 5.$$

It can be seen in claim 74, *prior to amendment*, that the phrase "the predetermine magnitude" had proper antecedent basis in lines 7-9 of claim 74 above (corresponding to lines 6-7 of the actual amendment on page 8 of Applicants' aforementioned reply of April 18, 2005), *i.e.*, "a predetermine magnitude defined as a modulus M in longitudinal traction of less than or equal to 50,000 Mpa."

In spite of there being explicit antecedent basis for the expression "the predetermine magnitude," Applicants amended claim 74 so that reliance upon antecedent basis was avoided, that is, by simply inserting the specific magnitude earlier recited in the claim. Accordingly, independent claim 74 was amended in Applicants' reply to the final Office action as follows (see page 8 of Applicants' reply, filed on August 23, 2005, to the final Office action; underlining and strikethrough markings being retained):

Claim 74. (*Currently Amended*) A laminate comprising:

a sandwich structure having a total thickness no greater than 3 mm, said sandwich structure comprising:

a core consisting essentially of a composite, the composite comprising a polymer resin matrix reinforced with fibers, the fibers of the composite consisting essentially of fibers having a ~~mechanical strength no greater than a predetermine magnitude~~ defined as a modulus M in longitudinal traction of less than or equal to 50,000 Mpa;

two fiber-reinforced composite layers, the core being positioned between the two layers, fibers of the two layers being different from the fibers of the core;

both of the two fiber-reinforced composite layers having a ~~mechanical strength greater than the predetermine magnitude of the mechanical strength of the fibers of said core~~ modulus M in longitudinal traction of less than or equal to 50,000 Mpa;

the core having a thickness  $e_2$  and the two layers have a total thickness  $e_3 + e_4$ , a ratio between the thickness of the core and the total thickness of the two layers being defined as follows:

$$e_2 / \frac{e_3 + e_4}{\quad} \leq 5.$$

**B. First Advisory Action**

In response to Applicants' reply under 37 CFR §1.116, filed on August 23, 2005, an Advisory Action (form PTOL-303) was mailed on September 14, 2005, denying entry of Applicants' amendment.

In Item No. 3(a) of that Advisory Action, it was explained that Applicants' amendments had not been entered because "[t]hey raise new issues that would require further consideration and/or search ...."

In the Continuation Sheet attachment to the Advisory Action, the reasons given in explanation of the determination that "new issues" had been raised are the following:

- Claim 73 was substantially amended and now requires fibers of the core to be selected from specific material; and
- Claim 74 requires the composite layers to have specific modulus in longitudinal traction

**C. Applicants' Request for Reconsideration**

On September 16, 2005, Applicants filed a Request for Reconsideration for the purpose of obtaining the entry of their amendment, explaining that no new issues were raised in the amendments of claims 73 and 74 as alleged in the Advisory Action.

In Applicants' Request for Reconsideration, they explained that, first, independent claim 73 was amended to incorporate therein the subject matter of former claim 25, which had depended directly from claim 73. That is, *claim 25 had previously required fibers of the core to be selected from specific material*. The specific material, then, was not newly added by Applicants' amendment of August 23, 2005. Accordingly, no new issue had been raised by the amendment made to claim 73.

Second, Applicants explained in their Request for Reconsideration, that the requirement in claim 74 stated above in the aforementioned Continuation Sheet of the Advisory Action, *i.e.*, "the composite layers to have specific modulus in longitudinal traction," had been recited in claim 74 *prior to Applicants' amendment* to the final Office action (as Applicants mentioned above).

That is, Applicants explained that in the subparagraph in lines 12-15 of claim 74, Applicants had previously referred to "the two fiber-reinforced composite layers having a mechanical strength greater than the predeterminate magnitude of the mechanical strength of the fibers of said core" (which is given as "less than or equal to 50,000 Mpa" in lines 7-8); and in their amendment of August 23, 2005, in place of the "the predeterminate magnitude of the mechanical strength of the fibers of said core" in lines 13-14, Applicants added the 50,000 Mpa value that had appeared (and still appears) in line 8.

**D. Second Advisory Action**

In response to Applicants' Request for Reconsideration, filed on September 16, 2005, a second Advisory Action (form PTOL-303) was mailed more than one month later, on October 20, 2005, again denying entry of Applicants' amendment.

In Item No. 3(c) of this second Advisory Action, it is explained that Applicants' amendment had not placed the application in better form for appeal by materially reducing or simplifying the issues for appeal .... Further, reference is made to the "Continuation Sheet" attachment which explains (in very small type at the upper edge of the sheet):

the proposed amdt. appear to expand/multiply the invention.  
first, the fiber core is selected from a specific group but same  
fiber is further selected from another specific group. The  
election of the fibers in the core, would entail several  
inventions, as submitted.

In Item 11 of the second Advisory Action, it is explained that "[t]he request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet." In the Continuation Sheet attachment, the reason given in explanation of the determination that the application has not been placed in condition for allowance is the following:

does NOT place the application in condition for allowance  
because: claim 73 now present several invention as the fiber  
core cold [sic] be any of several fiber material.



**II. Compliance with 37 CFR §1.181(c)**

This petition complies with the requirement of 37 CFR §1.181(c) in that Applicants have made a proper request for reconsideration of the Examiner's action of September 14, 2005, which denied entry of the amendment of August 23, 2005, which was followed by a repeated action by the Examiner, again denying entry of the amendment on October 20, 2005.

**III. Points to be Reviewed**

The points to be reviewed are whether Applicants' amendment filed on August 23, 2005 should be entered, and whether the reasons given by the Examiner in denying entry of the amendment comply with U.S. Patent and Trademark guidelines and rules, as appear in the Manual of Patent Examining Procedure (MPEP) and in the Code of Federal Regulations, Title 37.

**IV. Action Requested**

Applicants request that their amendment filed on August 23, 2005 be entered.

**V. Arguments in Support of Requested Action**

**A. Arguments Pertaining to First Advisory Action**

Because the reasons denying entry of Applicants' amendment of August 23, 2005 differ in the two Advisory Actions, Applicants submit that the latter Advisory Action (*viz.*, that which is dated October 20, 2005) is controlling, the first Advisory Action (*viz.*, that which is dated September 14, 2005) having been superseded.

If reasons presented in the first Advisory Action are not considered to have been superseded, Applicants then request entry of their amendment of August 23, 2005 for the reasons presented in their Request for Reconsideration that was filed on September 16, 2005.

**B. Arguments Pertaining to Second Advisory Action**

MPEP §714.12 (source: online at [www.uspto.gov](http://www.uspto.gov), "Last Modified 09/19/2005) provides the following:

Once a final rejection that is not premature has been entered in an application, applicant or patent owner no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. *Any amendment that will place the application either in condition for allowance or in better form for appeal may be entered. Also, amendments filed after a final rejection, but before or on the date of filing an appeal, complying with objections or requirements as to form are to be permitted after final action in accordance with 37 CFR 1.116(b).* (emphasis added)

The only reasons offered in the second Advisory Action for denying entry of Applicants' amendment, whether with regard to placing the application in better form for appeal or to placing the application in condition for allowance, appear to be directed to the amendment presented to independent claim 73.

*The amendment that Applicants have made to claim 73 that is cited in the second Advisory Action as justifying the denial of entry is merely that by which Applicants added the subject matter of allowable claim 25.*

That independent claim 73, as amended to include therein the subject matter of claim 25, should now "appear to expand the invention," as the Examiner contemplates at the top of the Continuation Sheet of the second Advisory Action, or "claim 73 now present several invention as the fiber core cold [sic] be any of several fiber material," also appearing on the Continuation Sheet, is irrelevant to the refusal to enter the amendment. The subject matter of claim 25 has been identified as "allowable" in the final Office action. See page Section 3 near the middle of page 2 thereof. By rewriting allowable claim 25 in independent form, *i.e.*, by incorporating the subject matter thereof into parent claim 73, Applicants had attempted to place the instant application in condition for allowance based upon the Examiner's indication of allowable subject matter.

MPEP §714.13 (source: online at [www.uspto.gov](http://www.uspto.gov), "Last Modified 09/19/2005") provides the following:

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see 37 CFR 1.116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under 37 CFR 1.116(b)(3) is expected in all amendments after final rejection.

In their amendment of August 23, 2005, Applicants did not add new claims or attempt to reinstate previously canceled claims. Applicants' amendment to claim 73 effectively presents allowable claim 25 in independent form.

With regard to Applicants' amendment, Applicants merely canceled claims (*i.e.*, dependent claims 25 and 41); adopted Examiner suggestions (*i.e.*, rather than arguing for the allowance of independent claim 73, they agreed to the allowance of claim 25 by rewriting it in independent form); and they removed issues for appeal (by no longer presenting independent claim 73 without the subject matter of allowable claim 25 and by resolving an indefiniteness rejection in both claims 73 and 74).

Accordingly, entry of Applicants' amendment of August 23, 2005 would be in compliance with the guidelines provided by MPEP §714.13.

## **VI. Summary and Conclusion**

For reasons presented in Applicants' Request for Reconsideration and for reasons presented above, Applicants kindly request that their amendment filed on August 23, 2005 be entered.

In short, Applicants' amendment is in compliance with the guidelines appearing in the MPEP, consistent with the provisions of 37 CFR §1.116.

No fee is believed to be due for this petition. However, the Commissioner is authorized to charge any fee required for acceptance of this petition as timely and/or complete to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,  
Philippe RENARD et al.

  
\_\_\_\_\_  
James L. Rowland  
Reg. No. 32,674

November 1, 2005  
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